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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/842,161 04/26/01 IWAI

H 206580US0

EXAMINER

022850 HM22/0816  
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ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/842,161

Applicant(s)

IWAI ET AL.

Examiner

Gina C Yu

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomomasa (Translation, JP 63-126543) in view of Kakoki et al. (U.S. Pat. No. 5,162,377).

Tomomasa teaches a transparent cosmetic microemulsion composition comprising:

- (a) a hydrophilic nonionic surfactant;
- (b) oil phase comprising (i) oil as described in p. 9, lines 18 – p. 11, lines 3 and

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(ii) oil as described in p. 11, line 4 – p. 12, line 18, wherein the weight ratio of oil (I) and (ii) is 1:0.001 to 1:07; and

(c) water, wherein the weight ratio of (a) to (b) is 1: 0.5 to 1:7.

Although the weigh ratio of surfactant to oil phase in the invention is less than required by the instant claims, the statement in the reference that prior arts required far more surfactants teaches a skilled worker that the composition may be formulated with higher amount of surfactant. See p. 13, lines 1-8. Furthermore, although the invention in the reference does not require a mixture of liquid and solid oils, it teaches that solids pose no problem if they are dissolved in the oil phase. See p. 11, lines 14 – 17. Thus instant claim 1 is met. The weight ratio of the average particle size of the emulsion particle is 0.01 to 0.1 um, meeting instant claim 3. See p. 6, line 24 – p. 7, line 1. Although Tomomasa does not explicitly teaches the range of the viscosity of the composition, it teaches that the composition may be comprise thickeners, and formulated into various compositions including shampoos, body lotions, cosmetic lotions, aerosol products, and cleansing jelly, which suggests that the composition may be formulated into final products that require different ranges of viscosity. See p. 14, lines 16 – 20; p. 15, lines 6 – 11; Working Example 19. Thus instant claims 4 and 5 are met. The reference further teaches that high shear force is generally applied method in emulsification, which is also disclosed by applicants in spec. p. 1, line 20 – p. 2, line 5. The reference is silent as to the value of the shear rate that may be applied during the emulsification process and the transparency of the composition as required by instant claims 6-7 and 2, respectively.

Kakoki et al. teach a transparent oil-in-water composition for cosmetic or pharmaceutical purposes, which comprises:

- (a) phospholipid and nonionic surfactants disclosed in col. 2, line 59 – col. 3, line 11;
- (b) oil components as disclosed in col. 3, line 11 – col. 4, line 11, which may be liquid or solid; and
- (c) water, wherein the weight ratio of the surfactant and oil is up to 1:10. See col. 2, line 11 – col. 4, line 43.

The reference teaches that higher shearing force is applied in emulsification process to achieve the improvement in transparency, safety and stability of the composition. See col. 4, line 44 – col. 5, line 23. Using the pressure of 500 psi, or 2000 psi or more during the shearing treatment process of the emulsion and then diluting with water or polyhydric alcohol is disclosed. The reference also teaches that the transmittance of the composition is 80% or higher when measured at 700nm. See col. 5, lines 46 – 49.

Examiner views that the optimal shearing rate applied to the composition or the transmittance of the composition would have been discovered by routine experiments.

Given the general teaching of high shear emulsification in Tomomasa, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior art for specific high shear rates for emulsification, as taught by Kakoki et al., because of the expectation to successfully produce a stable and transparent cosmetic composition.

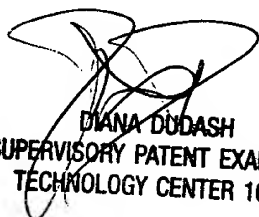
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
August 12, 2001



DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
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